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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,568	03/29/2001	Dillis V. Allen	G-38	4968

7590 05/15/2003

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EXAMINER

PASSANITI, SEBASTIANO

ART UNIT PAPER NUMBER

3711

DATE MAILED: 05/15/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,568

Applicant(s)

ALLEN ET AL.

Examiner

Sebastiano Passaniti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7 is/are allowed.
- 6) ☒ Claim(s) 8-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This Office action is responsive to communication received 02/24/2003 – paper styled, “RESPONSE TO OFFICE ACTION”.

Applicant's remarks with respect to the maintenance fees, the required supplemental reissue declaration and the pending litigation are acknowledged.

Claims 1-12 remain pending.

Following is an action on the MERITS:

Claims 8-12 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Specifically, as to claim 8, the applicant notes in his reissue declaration that claim 8 corresponds substantially to original patent claim 1 with the deletion of the phrase “having a top surface that is coplanar with or projects upwardly a short distance from the

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top wall" while also reciting that the ferrule is mounted "adjacent the hosel". Here, the applicant has failed to further recite that the ferrule has a downwardly depending flange seated "in a groove", as was the case in original claim 1 of the patent. The fact that the groove is an essential part of the claimed invention was vehemently argued on page 4 of the amendment received 11/23/1998 in parent application serial number 08/960,966.

Specifically, as to claim 9, the applicant notes in his reissue declaration that claim 9 corresponds substantially to original patent claim 6 with the cancellation of "on the hosel top surface" and the substitution therefor with the phrase "adjacent the hosel". Here, the applicant has failed to further recite that there exists an annular groove in the club head coaxial with the hosel bore and wherein the ferrule has an integral downwardly depending annular flange seated in the annular groove. Again, the fact that the groove is an essential part of the claimed invention was vehemently argued on page 4 of the amendment received 11/23/1998 in parent application serial number 08/960,966.

Specifically, as to claims 10, 11 and 12, the applicant notes in his reissue declaration that the phrase "substantially tangent" has been substituted for the term "tangent". Here, it is noted that the term "tangent" was specifically added by amendment to each of original claims 1, 6 and 7 and argued by the applicant in order to define over the prior art of record. See pages 1-3 of the amendment received 11/23/1998 in parent application serial number 08/960,966, wherein it is clear that the nature of the addition to the claims shows that this limitation (i.e., the addition of the term "tangent") was added in direct reply to the prior rejection.

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Claims 1-7 are allowable over the prior art references of record.


Claims 8-12 appear to avoid the prior art of record.

An initialed copy of the Information Disclosure Statement (IDS) received 05/13/2002 is enclosed with this Office action. The IDS has been slightly modified to facilitate the initialing, signing and dating of the IDS papers by the examiner. However, the content of the citations found on the IDS as filed by the applicant has not been altered.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 703-308-1006. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on 703-308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-308-7768 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.


Sebastiano Passaniti
Primary Examiner
Art Unit 3711

S.Passaniti/sp
May 14, 2003